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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,493	04/15/2004	Todd Fries	1735.ALA100-FOR	8565
26308 7590 07/01/2008 RYAN KROMHOLZ & MANION, S.C. POST OFFICE BOX 26618 MILWAUKEE, WI 53226				
EXAMINER				
MCLELLAND, KIMBERLY KEIL				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
07/01/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/825,493

Applicant(s)

FRIES ET AL.

Examiner

KIMBERLY K. MCCLELLAND

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 7-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 16-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The double patenting rejections of claims 1-6 over Application No. 11/527/293 is maintained. Applicant's preference to hold the rejection in abeyance is acknowledged. The rejection is maintained until appropriate action is taken.

Response to Amendment

2. Applicant is reminded they need to explicitly point out where support for all the newly claimed features comes from as required by MPEP 714.02 and 2163.06. See 37 CFR 1.111.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-6 and 16-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation presented in independent claims 1 and 5 of "at least one resilient wing member coupled to said circumferential wall" appears to be new matter. The current specification does not

disclose a resilient wing member. Applicant has not provided citations where this limitation can be found. Consequently, the newly added limitation is considered new matter. Claims 2-4, 6, and 16-25 are rejected due to their dependency on independent claims 1 and 5.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT International Publication No. WO88/01247 to Aguero in view of U.S. Patent No. 4,602,976 to Fukuda et al. and U.S. Patent No. 3,547,737 to Vici.

7. With respect to claim 1, Aguero discloses a cable marking apparatus, including a label roller assembly for supplying labels to said apparatus (column 4, lines 9-11); a rotatable puck mechanism (38), said puck mechanism having an interrupted circumferential surface (i.e. gap between 38a and 38b; See Figure 7) at least partially surrounding a cavity; means for rotating said puck mechanism (page 1, line 18); means for transporting at least one of said labels toward said an interruption in said puck mechanism circumferential surface (36; See Figures 9-10). Aguero does not specifically disclose means for transporting said peripheral surface of said elongate article through said interruption in of said puck member circumferential surface or at

least one resilient wing member coupled to said circumferential wall, said wing member extending into said cavity.

8. Fukuda et al. discloses a binding machine, including means for transporting said peripheral surface of said elongate article through said interruption in of said puck member circumferential surface (23; See Figures 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elongate article transporting means taught by Fukuda et al. with the apparatus of Aguero. The motivation would have been to effectively transport the article and prevent it from rotation during labeling (column 4, lines 30-35). It is well settled that it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. In re Venner, 120 USPQ 192.

9. Vici discloses an apparatus for wrapping, including at least one resilient wing member (47/48) coupled to said circumferential wall, said wing member extending into said cavity (See Figures 3 and 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the wing members of Vici with the apparatus of Aguero. The motivation would have been to better retain the article to be wrapped (column 3, lines 17-26).

10. As to claim 2, Aguero does not specifically disclose means for transporting said peripheral surface of said elongate object through said interruption in the puck member.

11. Fukuda et al. discloses a binding machine, including means for transporting said elongated article comprises a gripping mechanism (36), said gripping mechanism arranged to receive one of said elongate articles (15) and guide said of one said

elongate articles through said interruption in said rotatable puck mechanism circumferential surface (See Figures 1-2). Fukuda et al. does not describe the driving means for driving said gripping mechanism, but it is inherent the gripping means (36) of Fukuda et al. would include driving means in order to open and close the chucking arm and move the article by "suitable means" (column 4, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elongate article transporting means taught by Fukuda et al. with the apparatus of Aguero. The motivation would have been to effectively transport the article and prevent it from rotation during labeling (column 4, lines 30-35). It is well settled that it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. In re Venner, 120 USPQ 192.

12. As to claim 3, Aguero discloses at least one label sensor device (page 5, line 36- page 6, line 5).

13. As to claim 4, Aguero discloses a label roller assembly for supplying labels to said apparatus (column 4, lines 9-11); at least one gripper element for grasping and moving said elongate article (59); means for driving said gripper element (62); a rotatable puck mechanism(38), said puck mechanism having an interrupted circumferential surface (i.e. gap between 38a and 38b; See Figure 7) for receiving said elongate object (50); and means for rotating said puck mechanism (page 1, line 18; See Figures 9 and 10). However, Aguero does not specifically disclose said at least one gripper element being movable between a first position and a second position, said elongate article passing through an interruption in said puck mechanism circumferential

surface when said gripper element moves from said first position to said second position.

14. Fukuda et al. discloses a binding machine, including at least one gripper element (36) for grasping and moving said elongate article, and said at least one gripper element (36) being movable between a first position and a second position, said elongate article passing through an interruption in said puck mechanism circumferential surface when said gripper element moves from said first position to said second position (See Figures 1-2). Fukuda et al. does not describe the driving means for driving said gripping mechanism, but it is inherent the gripping means (36) of Fukuda et al. would include driving means in order to open and close the chucking arm and move the article by "suitable means" (column 4, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elongate article transporting means taught by Fukuda et al. with the apparatus of Aguero. The motivation would have been to effectively transport the article and prevent it from rotation during labeling (column 4, lines 30-35). It is well settled that it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. In re Venner, 120 USPQ 192.

15. As to claim 16, Aguero does not specifically disclose at least one wing member being movably biased towards said interruption.

16. Vici discloses an apparatus for wrapping, including at least one wing member being movably biased towards said interruption (47/48; See Figures 3 and 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made

to combine the wing members of Vici with the apparatus of Aguero. The motivation would have been to better retain the article to be wrapped (column 3, lines 17-26).

17. As to claim 17, Aguero does not specifically disclose said puck mechanism comprising two resilient wing members coupled to said circumferential wall, said wing members extending into said cavity.

18. Vici discloses an apparatus for wrapping, including two resilient wing members coupled to said circumferential wall, said wing members extending into said cavity (47/48; See Figures 3 and 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the wing members of Vici with the puck of Aguero. The motivation would have been to better retain the article to be wrapped (column 3, lines 17-26).

19. As to claim 18, Aguero does not specifically disclose said wing members being coupled to said circumferential wall on opposite sides of said interruption.

20. Vici discloses an apparatus for wrapping, including wing members (47/48) being coupled to said circumferential wall on opposite sides of said interruption (See Figures 3 and 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the wing members of Vici with the apparatus of Aguero. The motivation would have been to better retain the article to be wrapped (column 3, lines 17-26).

21. As to claim 19, Aguero does not specifically disclose said wing members being coupled to said circumferential wall at points substantially equidistant from said interruption.

22. Vici discloses an apparatus for wrapping, including wing members (47/48) being coupled to said circumferential wall at points substantially equidistant from said interruption (See Figures 3 and 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the wing members of Vici with the apparatus of Agüero. The motivation would have been to better retain the article to be wrapped (column 3, lines 17-26).

23. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over PCT International Publication No. WO88/01247 to Agüero in view of U.S. Patent No. 4,602,976 to Fukuda et al. and U.S. Patent No. 6,350,070 to Tasma and U.S. Patent No. 3,547,737 to Vici.

24. With respect to claim 5, Agüero discloses a cable marking apparatus, including a label roller assembly for supplying said labels and adhered backing strip to said apparatus (column 4, lines 9-11); label guide means for moving said labels through said apparatus (36); a label stripping assembly for removing said labels from said backing strip (31); a puck assembly (38), said puck assembly including a puck member having an interrupted circumferential surface (i.e. gap between 38a and 38b; See Figure 7). However, Agüero does not disclose gripper assembly for grasping and moving an elongate object through an interruption in said puck mechanism circumferential surface, a take up roll for receiving said backing strip, or at least one resilient wing member coupled to said circumferential wall, said wing member extending into said cavity.

25. Fukuda et al. discloses a binding machine, including gripper assembly for grasping and moving an elongate object through an interruption in said puck mechanism circumferential surface (23; See Figures 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elongate article transporting means taught by Fukuda et al. with the apparatus of Agüero. The motivation would have been to effectively transport the article and prevent it from rotation during labeling (column 4, lines 30-35). It is well settled that it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. In re Venner, 120 USPQ 192.
26. Tasma discloses a label applicator, including a take up roll for receiving said backing strip (column 3, lines 41-47). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the take-up spool taught by Tasma for the cutting edge of the cable marking apparatus disclosed by Agüero. The motivation would have been to ease the disposal of the waste backing.
27. Vici discloses an apparatus for wrapping, including at least one resilient wing member (47/48) coupled to said circumferential wall, said wing member extending into said cavity (See Figures 3 and 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the wing members of Vici with the apparatus of Agüero. The motivation would have been to better retain the article to be wrapped (column 3, lines 17-26).

28. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over PCT International Publication No. WO88/01247 to Aguero in view of U.S. Patent No. 4,602,976 to Fukuda et al. and U.S. Patent No. 3,547,737 to Vici as applied to claims 1-4 and 19-16 above, and further in view of U.S. Patent No. 4,770,729 to Spencer et al.

29. With respect to claim 24, Aguero does not specifically disclose said gripping mechanism adapted for linear reciprocating movement.

30. Spencer et al. discloses an apparatus for labeling elongate objects, including a gripping mechanism (116/117) adapted for linear reciprocating movement (See Figure 12D). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a gripping mechanism with linear reciprocating movement as taught by Spencer et al. in the device of Aguero. The motivation would have been allow direct linear alignment of the elongate articles with the puck entrance.

31. Claims 6 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT International Publication No. WO88/01247 to Aguero in view of U.S. Patent No. 4,602,976 to Fukuda et al. and U.S. Patent No. 6,350,070 to Tasma and U.S. Patent No. 3,547,737 to Vici as applied to claim 5 above, and further in view of U.S. Patent No. 4,055,616 to Keen et al.

32. As to claim 6, Aguero disclose at least a portion of the interruption (i.e. gap between 38a and 38b; See Figure 7) in said puck member circumferential surface is covered by a spring loaded (62) entrance door (56; See Figures 9-10). Aguero does not specifically disclose the spring entrance door is spring biased, hingedly mounted.

33. Keen et al. discloses an apparatus for separating a covering on a cable, including the spring entrance door is spring biased, hingedly mounted (42; See Figure 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the spring door taught by Keen et al. for the entrance door of Aguero et al. The motivation would have been to allow for easier opening and closing of the entrance door.

34. As to claim 25, Aguero disclose at least a portion of the interruption (i.e. gap between 38a and 38b; See Figure 7) in said puck member circumferential surface is covered by a spring loaded (62) entrance door (56; See Figures 9-10). Aguero does not specifically disclose the spring entrance door is hingedly mounted to the puck mechanism.

35. Keen et al. discloses an apparatus for separating a covering on a cable, including the spring entrance door is spring biased, hingedly mounted (42; See Figure 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the spring door taught by Keen et al. for the entrance door mounted on the puck mechanism of Aguero et al. The motivation would have been to allow for easier opening and closing of the entrance door.

Allowable Subject Matter

36. Claims 20-23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

37. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record neither shows nor suggests a puck member with a wing member with a first arm coupled to the circumferential wall and a second arm coupled to the first arm. The closest prior art of record, Aguero does not disclose any type of wing members. Another related reference, Vici, illustrates jaw members that resemble wing members in function, but do not include a first arm attached to the circumferential wall or a second arm attached to a first arm. There is no obvious reason to alter the jaws of Vici to include a first and second arm attached to the circumferential wall. Consequently, the subject matter of claims 20-23 is found to be patentably distinguishable over the current prior art.

Response to Arguments

38. Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection. Applicant's amendment necessitated the new grounds of rejection.

Conclusion

39. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIMBERLY K. MCCLELLAND whose telephone number is (571)272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Thr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip C. Tucker can be reached on (571)272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. K. M./
Examiner, Art Unit 1791

KKM

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791